

E.) REMARKS/ARGUMENTS

It is applicants' intent to place the present application in condition for allowance. To this end, applicants have complied with the Examiner's rejections and objections to the maximum extent possible.

Interview

On December 2, 2003, the undersigned attorney, Jonathan P. Miller, initiated a telephone interview with the Examiner, John P. Sheehan. During the interview, the undersigned and the Examiner discussed claims 1, 2, 4-18, and 21 and reached an agreement with respect to claims 1, 2, 4-18, and 21. The undersigned asked what could be done to overcome the new matter issues in the Office Action mailed November 21, 2003 (not mailed November 11, 2003, as indicated by the Examiner's Interview Summary). It was agreed that the undersigned would submit ASM certifications or textbook definitions for each of the alloy designations. If the alloys are defined in these sources, then the undersigned would consider making amendments to change the proportions to ranges. With respect to changing Inconel 903, 907 and 909 to INCOLOY 903, 907 and 909, the undersigned explained to the Examiner that Inconel 903, 907 and 909 do not exist and that one of ordinary skill in the art would recognize this and realize that INCOLOY 903, 907 and 909 were intended. The Examiner suggested that Applicants make this argument and preferably support the argument with a declaration by Applicants to make this point.

Claim 21

In their response dated September 12, 2003, Applicants noted that there was no claim 21 in the application. In the Office Action dated November 21, 2003, the Examiner directed Applicant's attention to the Preliminary Amendment submitted December 27, 2002 (page 2) where claim 21 was added as a new claim. Applicants acknowledge that claim 21 is in fact a claim in this Application and have included it herein in the

Amendments to the Claims section.

Rejections under 35 U.S.C. § 132

The Examiner rejected Applicants' amending the designation "Inconel" to "INCOLOY®" because of inconstancies between the claims and the specification. The Examiner noted with respect to amending Inconel 907 to INCOLOY® 907, that "[a]lthough it is obvious that there is an error, that either original claim 13 or original paragraph 0022 is incorrect, it is not obvious that original paragraph 0022 is, in fact, wrong." The Examiner noted with respect to amending Inconel 909 to INCOLOY® 909, that "[a]lthough it is obvious that there is an error, that either original claim 16 or original paragraph [0023] is incorrect, it is not obvious that original paragraph 0023 is, in fact, wrong." The Examiner noted with respect to amending Inconel 903 to INCOLOY® 903, that "[a]lthough it is obvious that there is an error, that either original claim 10 or original paragraph 0024 is incorrect, it is not obvious that original paragraph 0024 is, in fact, wrong."

In the Interview on December 2, 2003, the undersigned explained to the Examiner that Inconel 903, 907 and 909 do not exist and that one of ordinary skill in the art would recognize this and realize that INCOLOY 903, 907 and 909 were intended. The Examiner suggested that Applicants make this argument and preferably support the argument with a declaration by Applicants to make this point.

Applicants hereby submit that Inconel 903, 907 and 909 do not exist and that one of ordinary skill in the art would recognize this and realize that INCOLOY 903, 907 and 909 were intended. In support of this contention, Applicants have submitted an Affidavit under 37 CFR § 1.132 (the "Affidavit") by one of the Applicants, Thomas J. Kelly ("Mr. Kelly"). As set forth in the Affidavit, Mr. Kelly is a joint inventor of all the claims of the patent application identified above and is a joint inventor of the subject matter described and claimed therein. Mr. Kelly has extensive knowledge of the compositions and trademarks of superalloy materials and is skilled in the art of superalloy compositions. Mr. Kelly attests

to the fact that, to his knowledge, the trademark “Inconel 903” for a superalloy material does not exist in the art and the use of such a designation would be recognized by one skilled in the art as referring to the trademark “INCOLOY® 903.” Mr. Kelly also attests to the fact that, to his knowledge, the trademark “Inconel 907” for a superalloy material does not exist in the art and the use of such a designation would be recognized by one skilled in the art as referring to the trademark “INCOLOY® 907. Mr. Kelly also attests to the fact that, to his knowledge, the trademark “Inconel 909” for a superalloy material does not exist in the art and the use of such a designation would be recognized by one skilled in the art as referring to the trademark “INCOLOY® 909.” Mr. Kelly further attests to the fact that the term INCOLOY® generally is used with reference to an alloy falling in the family of iron-base superalloys and to the fact that the term INCONEL® generally is used with reference to an alloy falling in the family of nickel-base superalloys. In addition, Mr. Kelly attests to the fact that he has observed incorrect usages of the terms INCOLOY® and INCONEL® and that examples of such incorrect usages are available on the Internet. In addition, the undersigned, Applicant’s attorney, has searched the USPTO Trademark database and has determined that the USPTO has not issued trademarks for “INCONEL 903”, “INCONEL 907,” or “INCONEL 909” as of the date of the filing of this response. As it is clear from the evidence herein submitted that Inconel 903, 907 and 909 do not exist and that one of ordinary skill in the art would recognize this and realize that INCOLOY 903, 907 and 909 were intended, Applicants respectfully request that the Examiner withdraw his rejection under 35 U.S.C. § 132 with respect to the amendments of Inconel 903 to INCOLOY 903, Inconel 907 to INCOLOY 907, and of Inconel 909 to INCOLOY 909.

The Examiner also rejected Applicants’ amendments to paragraphs [0003], [0014], [0021], [0022], [0023], and [0024] as being drawn to new matter. As the Examiner noted “[e]ach of these paragraphs has been amended to include the specific compositions for one or more of INCONEL® 718, WASPALOY™, RENE®-41, INCOLOY® 903, INCOLOY® 907 and INCOLOY® 909.” The Examiner disagreed with Applicants’ contention that the inclusion of the specific alloy composition is not an inclusion of new matter.

In the Interview on December 2, 2003, in order to overcome this rejection, it was agreed that the undersigned would submit ASM certifications or textbook definitions for each of the alloy designations. Applicants have submitted several sheets of nominal compositions for these particular materials from the ASM Advanced Materials & Processes publication ("ASM Publication"), dated December 2001. As some of the compositions that Applicants originally submitted were different than the compositions set forth in the ASM Publication, Applicants have amended the specification and the claims accordingly. Applicants note that the INCONEL® 718 designation appears in the ASM Publication as "IN-718." As these compositions are clearly industry standard compositions as set forth by the ASM Publication, Applicants submit that no new matter has been added by the inclusion of the specific alloy compositions in the specification and respectfully request that the Examiner withdraw his rejection under 35 U.S.C. § 132.

Rejection under 35 U.S.C. § 112

This application has been reviewed in light of the Office Action of November 21, 2003. In the Office Action, claims 1, 2, 4-18 and 21 were pending, and claims 1, 2, 4-18 and 21 stand rejected. In response, Applicants have amended claims 1, 4, 7, 10, 13, and 16, and the following remarks are submitted.

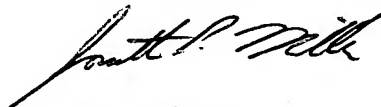
Claims 1, 4, 7, 10, 13, and 16 have been amended to include the specific alloy compositions for INCONEL® 718, WASPALOY™, RENE®-41, INCOLOY® 903, INCOLOY® 907, and INCOLOY® 909, which are well-known superalloys with specific known compositions to those skilled in the art, as set forth by the ASM Publication. As Applicants have now included clear evidence that INCONEL® 718, WASPALOY™, RENE®-41, INCOLOY® 903, INCOLOY® 907, and INCOLOY® 909, are known superalloys with specific known compositions, and since Applicants have amended the specification and claims accordingly, Applicants respectfully request that the Examiner withdraw his rejection of claims 1, 2, 4-18 and 21 under 35 U.S.C. § 112.

CONCLUSION

Applicants submit that no new matter has been added by the amendments to the specification and the claims as the compositions of each alloy listed in the specification was in the public domain at the time the application was filed as evidenced by the attached ASM Publication. Applicants submit that the application is now in condition for allowance, and requests such allowance. If the Examiner believes the prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact applicants' representative at the below listed telephone number.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
MCNEES WALLACE & NURICK LLC



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Attachment:

Marked-Up Copy of Substitute Specification
Clean Copy of Substitute Specification
Affidavit of Thomas J. Kelly Under 37 CFR § 1.132
Pages (3) from ASM Advanced Materials and Processes – December 2001